

### **REMARKS**

Reconsideration and withdrawal of the rejections of the claimed invention is respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

#### **I. STATUS OF CLAIMS AND FORMAL MATTERS**

Claims 1, 2, 5-7, 11-14, 18, 22 and 23 are pending in this application. Applicants note that the elements of previous claim 8 has been inserted into claim 1. New claim 23 incorporates the elements of claims 5 and 6 into claim 2. No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

#### **II. THE 35 U.S.C. 112, 2<sup>nd</sup> PARAGRAPH REJECTION HAS BEEN OVERCOME**

Claims 1, 2, 5-8, 11-14 and 18 were rejected as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention. The applicants request reconsideration of this rejection in light of the above amendments to the claims

#### **III. THE 35 U.S.C. 102(b) REJECTION HAS BEEN OVERCOME**

Claims 1, 2, 5-7, 11-12, 14 and 18 were rejected as allegedly being anticipated by Moss (US 4,053,984 - "Moss"). The applicants request reconsideration of this rejection for the following reasons.

Claim 8 was not included in the rejection of the claims over Moss. As the elements of claim 8 are now part of amended claim 1, this rejection has been rendered moot. The applicants reserve the right to continue prosecution on the scope of original claim 1 in a continuing application.

#### **IV. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME**

Claims 8 and 13 were rejected as allegedly being obvious by Moss in view of Bradley et al. (US 5,626,128 - "Bradley"). The applicants request reconsideration of this rejection for the following reasons.

##### ***Background***

In order to establish a *prima facie* case of obviousness, all claim limitations must be taught or suggested by the prior art reference or from knowledge which is notorious to those of ordinary skill in the art. As noted above, the elements of claim 8 has been inserted into claim 1 which would render the applicants claims 1, 2, 5-7, 11-12, 14 and 18 to be unobvious but for the rejection of Moss in view of Bradley. However, as is discussed below, the combination of Moss and Bradley does not render the applicants' claims 8 and 13 to be obvious. (Also, attention is directed toward new claims 22 and 23 which refer to elements not previously considered and are also distinguished from the Moss and Bradley rejections).

##### ***Differences between Moss and the applicants' invention not heretofore acknowledged***

Moss refers to a dental appliance which is used for propping open the mouth of a patient, and also to extract saliva thereby to provide a dry working environment. In order to achieve this effect, Moss refers to opposing flexible tubular frames that are locatable inside the mouth of a patient. The frame is hollow (para 2, line 3 - 'tubular') and includes a plurality of apertures to facilitate removal of saliva from the mouth area (par 2 line 64). The saliva is therefore conveyed through the tubular frame, and is ejected from the frame via a saliva ejector (par 2 line 66). The saliva ejector is in the form of a cylindrical tube that is in flow communication with the interior of the tubular frames, and an opposite end of the ejector is typically also in flow communication with a vacuum source. The ejector essentially forms part of the drainage passage defined by the tubular frame, and therefore *does not constitute a medical tube located in the airway of a patient*, as is envisaged in the present invention. The article therefore also *does not constitute a 'medical tube retaining device'*.

Moss' dental appliance furthermore includes a tongue deflector 34, which is located in the general vicinity of the ejector, but which is not operatively associated with the ejector. The tongue deflector 34 includes an elongated section 38 which is shaped to abut a large portion of the patient's tongue when the appliance is used, and a curved section 40 which provides

resilience to depress the tongue downward into the mouth cavity upon insertion of the appliance. The tongue deflector therefore *does not in any way constitute a guide means for a tube* (even if the ejector is interpreted as being a medical tube as is envisaged in the present invention). Also, *Moss discloses no other tube guide means which fulfills the function of the tube guide means in accordance with the invention*, as the ejector is rigidly secured to the frame, and therefore a tube guide means would be redundant in the context of Moss.

A further essential difference is that even if the tongue deflector, or some area near the tongue deflector, is interpreted as being a ‘medical tube guide means’, the medical tube guide means as disclosed in Moss *does not disclose securing means for securing the medical tube against longitudinal displacement*.

With respect to claim 6, a further difference between the present invention and the disclosure in Moss resides in the fact that the guiding means in the present invention is located “eccentrically the working gap” (previous claim 6). According to the Concise Oxford English Dictionary eccentrically means “not placed centrally”.

Also, with regard to the figures, it is readily apparent that the guiding means is eccentric in a horizontal plane – i.e. it is disposed toward a side of the working space. In order to improve readability of the claim language, claim 6 has been amended to read “the guide means is located towards a side of the working gap” (although if required for the purposes of allowance, the applicants are amenable to substituting the original claim language which is intended to be of the same scope as the present language). The importance of this feature is that the configuration is optimal when the guiding means, and therefore the medical tube guided thereby, is located towards the side of the working space, as this arrangement provides for minimum obstruction of the working gap unlike the devices taught by Moss and Bradley.

As such, the differences between the combination of Moss and Bradley and the applicants’ claimed invention is substantial, in that Moss does not include a medical tube, tube guide means or securing means. These are the essential elements of the present invention. One having ordinary skill in the art would therefore have had to modify Moss by adding the medical tube, the medical tube guide means and the securing means, and it is respectfully submitted that this would extend beyond a mere obvious modification especially given the number of permutations of possible changes represented by the combination of Moss and Bradley, i.e. the

combination of Moss and Bradley does not represent a finite number of solutions to a problem especially when the skilled artisan is not in possession of the applicants' claims as does the Examiner for making a determination of patentability.

This is especially true when one considers that the purpose of Moss (drainage of the mouth cavity via the frame of the device) is substantially different to the purpose of the present invention and to that of Bradley (releasably securing a medical tube in an air passage of a patient), i.e. there was no reason for the requisite substitutions from Bradley to be made for the teachings of Moss nor would there have been any reasonable expectation of success for the modification.

With respect to claim 6, it is furthermore observed that neither Moss nor Bradley discloses a securing means that is disposed toward the side of the working gap, and it is submitted that this feature (being the subject matter of amended claim 6) is not rendered obvious by the combination of Moss and Bradley.

For these reasons, the combination of Moss and Bradley does not render the applicants' claimed invention to be obvious as all of the claimed elements are not taught or suggested.

**CONCLUSION**

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution.

Respectfully submitted,  
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